

Remarks:

Claims 1-3 are pending in the application.

Claims 1-3 stand finally rejected.

Claims 1 and 2 have been cancelled by the amendment herein. Cancellation of these claims is being made to progress prosecution of claim 3, and Applicant reserves the right to file a continuing application for the cancelled subject matter.

Claims 1-3 stand finally rejected under 35 U.S.C. 102(a) as being anticipated by Chiesi et al (US 5,773,029).

Claims 1 and 2 have been cancelled. Claim 3 is drawn to a method of determining a useful salt from among a series of salts of a particular medicinal compound for use for a particular purpose. Operation of the method as claimed requires the completion of six steps:

- a. **determining** a quantity of said medicinal compound required for therapeutic efficacy;
- b. **choosing** a maximum total dose in which to administer said quantity of medicinal compound;
- c. **calculating** the minimum required solubility of a salt of said compound necessary to formulate said maximum total dose;
- d. **obtaining** said series of salts;
- e. **determining** the equilibrium solubility of each of said salts in said cyclodextrin; and
- f. **selecting**, as said useful salt, a salt from said series having an equilibrium solubility in said cyclodextrin sufficient to permit making a total dose equal to or less than said maximum total dose.

It is respectfully submitted that Chiesi et al does not anticipate the claim 3 because it does not disclose all of the elements in the claim. No disclosure was found in Chiesi et al for at least steps (a), (b), (c) and (f). It is well settled that to anticipate, a single reference must teach each and every limitation of the claimed invention. *Eolas Technologies Inc. v. Microsoft Corp.*, 73 USPQ2d 1782, 1790 (Fed. Cir. 2005), citing *EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1350 [60 USPQ2d 1423] (Fed. Cir. 2001). The Office clearly recognizes this and provides in the MPEP, at § 2131, that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference.", citing *Verdegall Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Chiesi et al does not expressly or inherently set forth at least steps (a), (b), (c) and (f) of claim 3, which are elements of the claim, Chiesi et al can not anticipate claim 3.

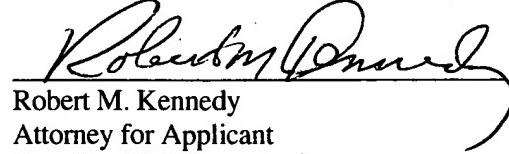
In the Final Office Action of October 20, 2004, the Examiner stated that Applicant's arguments, filed may 24,

2004, that Chiesi et al failed to teach all of the elements of the rejected claims were not persuasive since the rejected claims failed to set forth the target solubility of a specific salt or the solubility of specific salts in an aqueous cyclodextrin solution or specific steps of how the solubility of the salts are measured. In response to the Final Office Action, Applicant pointed out that the failure of the present claims to set forth the features mentioned by the Examiner was not believed to be pertinent to a determination of whether certain elements of the rejected claims are disclosed in the Chiesi et al reference so as to anticipate those claims. In the Advisory Action the rejection was maintained for the same reasons without explanation as to why the Examiner believes the failure of the claims to set forth the solubilities etc is pertinent. Claim 3, the only claim pending in the application after entry of the present amendment, sets forth six separate and well-defined steps to be conducted in the practice of the claimed method. The fact that the claim does not specify target solubilities or solubilities of specific salts or specific steps on how solubilities are measured does not detract from the fact that at least steps (a), (b), (c) and (f) are not found, either expressly or inherently, in Chiesi et al.

In view of the present amendment and the comments above, it is respectfully requested that the rejection of claim 3 under 35 U.S.C. 102(a) as being anticipated by Chiesi et al be reconsidered and withdrawn. This application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

Respectfully submitted,

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